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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,424	07/18/2000	Yoichi Taya	49979	9451

7590

11/04/2002

Edwards & Angell LLP  
Dike Brownstein Roberts & Cushman  
1101 Federal Street  
Boston, MA 02210

EXAMINER

PADMANABHAN, KARTIC

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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**Advisory Action**

Application No.

09/618,424

Applicant(s)

TAYA ET AL.

Examiner

Kartic Padmanabhan

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 16-23.Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



LONG V. LE

SUPERVISORY PATENT EXAMINER

10/30/02

Continuation of 3. Applicant's reply has overcome the following rejection(s): the 35 USC 103 rejections over Gu et al. and Gue et al. in view of Poethke et al. due to applicant's argument that the antibodies of Gu et al. bind to both acetylated and unacetylated peptide substrate, unlike the claimed invention. However, it is noted that applicant has argued that the antibodies of the present invention bind the acetylated form of the peptide substrate without "significantly" recognizing the unacetylated form. However, the claims, as recited, require antibodies that do not recognize unacetylated peptide substrates to any degree. Therefore, applicant's arguments raises a question as to whether the present invention, as claimed, is enabled.

Continuation of 5. does NOT place the application in condition for allowance because: of reasons set forth in the previous office action. In addition, applicant's argument that the applied references fail to teach a screening assay is irrelevant because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Also, applicant's argument that the Lill reference fails to teach detection of acetylated p53 is erroneous. As applicant acknowledges, Lill teaches detection of p-53-p300/CBP complex. Since the p300/CBP complex inherently has acetyltransferase activity (See Gu et al.), when it is bound to p53, p53 is acetylated. Applicant's argument that Lill teaches antibodies that the acetyltransferase complex and not the peptide is moot. Since the antibodies bind only to the acetyltransferase, the antibodies cannot bind unacetylated peptide, but do indeed bind the p-53-p300/CBP complex. Read broadly, the claim only requires an antibody that binds to the acetylated form of the peptide, whether directly or indirectly, and not the unacetylated form, which the Lill reference teaches. Applicant's argument with respect to the Poethke reference relies on the premise that Lill et al. does not form the basis of a proper 103 rejection, a position that has already been addressed.